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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,236	01/05/2001	Kenichiro Imai	450100-02940	3751
20999	7590	02/14/2005	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			MANOSKEY, JOSEPH D	
			ART UNIT	PAPER NUMBER
			2113	

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/755,236	IMAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph Manoskey	2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 November 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Circello et al, U.S. Patent 5,964,893, hereinafter referred to as “Circello”.

3. Referring to claims 1 and 6, Circello teaches a data processing system executing both breakpoint and trace functions in real time, this is interpreted as a monitoring system (See Col. 3, lines 24-30). Circello teaches the system being attached to an external development system, this is interpreted as an external monitoring means for monitoring the state of a controller within an apparatus to be monitored, the state being obtained when a control program stored in storage means in the apparatus controls, via an internal bus of the apparatus, said controller to operate (See Fig. 1 and Col. 3, lines 24-30).

Circello discloses the system, which operates in real time, being monitored containing a debug module that contains address breakpoint registers

and comparators, this is interpreted as a bus-access detection means for detecting, in real time, based on internal bus information, each match of an address set with an address line on said internal bus by said controller; said bus-access detection means being external to said controller and internal to said apparatus (See Fig. 1 and 2, Col. 3, lines 24-30, and Col. 5, lines 40-49).

Finally, Circello discloses the debug module, of the system that operates in real time, being connected to the external development system to send and receiving data, this is interpreted as wherein information on each match is output to said external monitoring means in real time (See Fig. 1 and 2, and Col. 3, lines 24-30).

4. Referring to claims 2 and 7, Circello discloses the system, which operates in real time, being monitored containing a debug module that contains program counter breakpoint registers and comparators, this is interpreted as comprising execution address detection means for detecting execution address information of said external monitoring means in real time based on said internal bus information, said execution address means being external to said controller and internal to said apparatus (See Fig. 1 and 2, Col. 3, lines 24-30, and Col. 5, lines 40-49).

Finally, Circello discloses the debug module, of the system that operates in real time, being connected to the external development system to send and receiving data, this is interpreted as wherein the execution address information is

output to said external monitoring means in real time (See Fig. 1 and 2, and Col. 3, lines 24-30).

5. Referring to claims 3, 4, 8, and 9, Circello teaches the system displaying the response to an external user (See Col. 8, lines 34-36).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Circello in view of Fasang, U.S. Patent 4,433,413.

8. Referring to claims 5 and 10, Circello teaches all the limitations (See rejection of claims 3 and 8) except for the data being displayed numerically, however Circello does disclose displaying the response to an external user but remains silent about what format the data is displayed in (See Col. 8, lines 34-36). Fasang teaches a device and method of testing a microprocessor system that includes a display where the data is formatted numerically (See Fig. 1, Col. 3, lines 20-31, and Col. 24, lines 5-9). It would have been obvious to one of

ordinary skill in the art at the time of the invention to display the data in the numerical format of Fasang on the display of Circello. This would have been obvious to one of ordinary skill in the art at the time of the invention to do this because it better conveys information to the outside world (See Fasang, Col. 3, lines 30-32).

***Response to Arguments***

9. Applicant's arguments, see pages 5 and 6 of amendment, filed 8 November 2004, with respect to the rejection(s) of claim(s) 1-10 under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Circello, see above rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Manoskey whose telephone number is (571) 272-3648. The examiner can normally be reached on Mon.-Fri. (7:30am to 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDM  
February 9, 2005

*Robert Beausoliel*  
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